

REMARKS

The applicant respectfully requests reconsideration in view of the amendment and the following remarks. In order to expedite prosecution the applicant has incorporated claim 5 into claim 1. The applicant believes that this amendment does not raise new consideration or require a new search since claim 5 was explicitly rejected.

Claims 1, 3, 6 and 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toshiaki et al., European Patent Publication No. 920808 ("Toshiaki"). Claims 5, 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toshiaki and Sears et al., U.S. Publication No. 2002/0000683 ("Sears"). The applicant respectfully traverses this rejection.

Rejection of Claims 1, 3, 6 and 9-12

Claims 1, 3, 6 and 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toshiaki. In order to expedite prosecution the applicant has incorporated claim 5 into claim 1. Claim 5 was not rejected over this rejection. Therefore, this rejection should be withdrawn.

Rejection of Claims 5, 14 and 15

Claims 5, 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toshiaki and Sears. The Examiner has relied upon Sears for teaching these features.

The applicant does not believe that Sears is a combinable reference for the following reasons. Sears discloses improved composite materials containing cellulosic pulp fibers dispersed in a matrix wherein the matrix comprises a polymeric material, e.g., polyamide (see paragraph nos. 2 and 24 of Sears). Sears further discloses that the composite may comprise greater than 1% and less than 60 by weight cellulosic pulp fibers (see paragraph no. 16 of Sears). The composite materials containing the cellulosic pulp fibers can be used for extrusion methods,

e.g., in injection molding applications (see paragraph no. 26 of Sears). Sears relates to a totally different technical field compared to the present application. The disclosure of Sears is totally silent about food casings and is also totally silent about multi-layered food casings. In addition, Sears has nothing to do with biaxially stretched seamless tube casings, but instead is directed to fiber-reinforced plastic material which is intended to be used in injection molding applications. The applicant does not believe that one of ordinary skill in the food casing art would consider Sears as an applicable reference. Sears is related to a totally different field of art.

In the applicant's specification the applicant has shown examples and comparative examples which establish the advantage of the applicant's claimed invention (see Table 1 of the applicant's specification).

The combination the Examiner is proposing and the arguments of the Examiner with respect to Toshiaki in combination with Sears is contradictory to what would actually occur. Sears just teaches to use a mixture of polyamide and cellulose acetate propionate and this in combination with Toshiaki would lead to a cellulosic material which is comprised within a casing and then should improve the smoke properties of the casing. However, this does not occur. On the contrary, a person skilled in the art would be prevented from using the teaching of Sears to merely mix cellulosic material and polyamide, since pure polyamide casings are not appropriate according to Toshiaki if smoke properties are an issue (see paragraph no. 0003 of Toshiaki). Therefore, there is no hint in Toshiaki to use the cellulose acetate propionate. However, the inventors of the present application have found that biaxially stretched casings having good smoke properties can be provided without using cellulose acetate propionate, only by using a mixture of polyamide and natural fibers, as claimed in claim 1 of the application.

Furthermore as stated above, Sears relates to a totally different technical field compared to the present application. A statement that modifications of the prior art to meet the claimed invention would have been “obvious to one of ordinary skill in the art at the time the invention was made” because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). See MPEP § 2143.01 IV. “[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007) quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). Furthermore, the Examiner cannot selectively pick and choose from the disclosed parameters without proper motivation as to a particular selection. The mere fact that a reference may be modified to reflect features of the claimed invention does not make the modification, and hence the claimed invention, obvious unless the prior art suggested the desirability of such modification. *In re Mills*, 916 F.2d 680, 682, 16 USPQ2d 1430 (Fed. Cir. 1990); *In re Fritch*, 23 USPQ2d 1780 (Fed. Cir. 1992). Thus, it is impermissible to simply engage in a hindsight reconstruction of the claimed invention where the reference itself provides no teaching as to why the applicant’s combination would have been obvious. *In re Gorman*, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991).

Again, there must be same reason provided by the Examiner either based on the references or found in the knowledge generally available to one ordinary skill in the art to combine and modify the references teaching in order to arrive at the claimed invention; and there

must be a reasonable expectation of success in doing so. The applicant is of the opinion that a person of ordinary skill in the art would have no motivation to combine and modify Toshiaki with Sears as suggested by the Examiner in order to arrive at the claimed invention. Sears is considered to be clearly inappropriate to be used by a person skilled in the art when dealing with casings for foodstuff.

It is necessary that a person skilled in the art has some motivation, first, to consider a specific document and, second, has motivation to combine these documents. The applicant believes that a person of ordinary skill in the art would not consider the secondary document, Sears, as a relevant teaching in context with the claimed subject matter. For the above reasons, this rejection should be withdrawn.

In view of the above amendment, applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 03-2775, under Order No. 15551-00003-US from which the undersigned is authorized to draw.

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Respectfully submitted,

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